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DATE MAILED: 11/06/2006

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------|----------------|----------------------|-----------------------|------------------|
| 10/613,744 | 07/03/2003 | Roderick MacKinnon | 600-1-220CIP1DIV 5620 | |
| 23565 75 | 590 11/06/2006 | | EXAMINER | |
| KLAUBER & | JACKSON | | STANDLEY, STEVEN H | |
| | SACK AVENUE | | ART UNIT PAPER NUMBER | |
| HACKENSACK, NJ 07601 | | 1649 | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) | |
|--|--|--|--|
| | 10/613,744 | MACKINNON, RODERICK | |
| Office Action Summary | Examiner | Art Unit | |
| | Steven H. Standley | 1649 | |
| The MAILING DATE of this communication ap Period for Reply | pears on the cover sheet with the c | orrespondence address | |
| A SHORTENED STATUTORY PERIOD FOR REPL WHICHEVER IS LONGER, FROM THE MAILING D. - Extensions of time may be available under the provisions of 37 CFR 1. after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period. - Failure to reply within the set or extended period for reply will, by statut Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b). | OATE OF THIS COMMUNICATION 136(a). In no event, however, may a reply be time will apply and will expire SIX (6) MONTHS from e, cause the application to become ABANDONE | N. sely filed the mailing date of this communication. D (35 U.S.C. § 133). | |
| Status | | | |
| 1) Responsive to communication(s) filed on 24 J | l <u>uly 2006</u> . | | |
| 2a) This action is FINAL . 2b) ☑ Thi | s action is non-final. | | |
| 3) Since this application is in condition for allowa | ance except for formal matters, pro | secution as to the merits is | |
| closed in accordance with the practice under | Ex parte Quayle, 1935 C.D. 11, 45 | 53 O.G. 213. | |
| Disposition of Claims | | | |
| 4) Claim(s) 1-58 is/are pending in the application 4a) Of the above claim(s) 1-15,17-22,30-36 ar 5) Claim(s) is/are allowed. 6) Claim(s) 15,23-29 and 37-44 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/o | <u>nd 45-58</u> is/are withdrawn from cor | nsideration. | |
| Application Papers | | | |
| 9) The specification is objected to by the Examina 10) The drawing(s) filed on is/are: a) accomposed and accomposed applicant may not request that any objection to the Replacement drawing sheet(s) including the correct of the oath or declaration is objected to by the Examination is objected. | cepted or b) objected to by the lead of a cepted or b) objected to by the lead of a cepted of the drawing(s) is objection is required if the drawing(s) is objection is | e 37 CFR 1.85(a). jected to. See 37 CFR 1.121(d). | |
| Priority under 35 U.S.C. § 119 | | | |
| 12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority document 2. Certified copies of the priority document 3. Copies of the certified copies of the priority application from the International Bureat * See the attached detailed Office action for a list | nts have been received. Its have been received in Applicationity documents have been received in the received | on No ed in this National Stage | |
| | | | |
| Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 7/03. | 4) | ate | |

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Art Unit: 1649

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group II (claims 16, 23-29, and 37-44) in the reply filed on 7/24/06 is acknowledged. After a review of the claims the examiner determined that claims 16 and 23 had been mis-grouped into group II when in fact the claims are to a polypeptide and not a nucleic acid or a method of making. The examiner called Sarah J. Fashena, the attorney of record, and gave here the opportunity again to choose a group in consideration that claims 16 and 23 were actually part of Group I. She elected Group II again. Therefore, claims 24-29 and 37-44 are now under consideration.

Priority

2. SEQ ID NO: 17 was disclosed in the application 09/045529. Therefore the priority is set at 3/20/1998.

Claim Objections

3. Claim 25 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 25 is dependent on claim 24, however claim 25 could be infringed without infringing on claim 24. Therefore it is not limiting but broader in scope.

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Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 24-29 and 37-44 are rejected under 35 U.S.C. 112, first paragraph. as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims all recite 'degenerate variants' or 'conservative variants' thereof. However, the specification does not define 'degenerate variants' and defines conservative variants very broadly. Further, 'degenerate variants' refers to both nucleic acids and polypeptides in the specification, indicating 'degenerate variants' is not used by the applicant to mean nucleic acid variants that vary at the third position in each codon. Therefore written description of 'degenerate variants' is lacking. On page 51 conservative substitutions are defined on lines 10-15 as being substitution with amino acids having a 'particular size' or 'characteristic' without providing any further detail as to what constitutes a conservative substitution.

The claims are drawn polypeptides or nucleic acids that are 'degenerate variants' or 'conservative variants. Many claims (24-29, and 37-44) do not require that the polypeptides, or the nucleic acid encoding the polypeptide, possess any particular biological activity, nor any particular conserved structure,

or other disclosed distinguishing feature. Therefore, there are no clear structural limitations on the complex of polypeptides claimed.

To provide evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. In the instant application, no such distinctions have been made. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, the only factor present are degenerate or conservative variants of an 'ion channel, or no functional recitation at all (see above).

Accordingly, in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description of the claimed genus.

Vas-Cath Inc. v. Mahurkar, 19USPQ2d 1111, clearly states that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116). As discussed above, the skilled artisan cannot envision the detailed chemical structure of the encompassed genus of polynucleotides, and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written

description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. The compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

One cannot describe what one has not conceived. See *Fiddes v. Baird*, 30 USPQ2d 1481 at 1483. In *Fiddes*, claims directed to mammalian FGF's were found to be unpatentable due to lack of written description for that broad class. The specification provided only the bovine sequence.

Therefore, only polypeptides comprising the nucleic acid (SEQ ID NO: 17) encoding the amino acid sequence set forth in a SEQ ID NO: 16, but not the full breadth of the claim meets the written description provision of 35 U.S.C. §112, first paragraph. Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 U.S.C. §112 is severable from its enablement provision (see page 1115).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 24-29, and claims 37-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recited "the prokaryotic channel of claim 15 encoded by a DNA sequence of SEQ ID NO: 17, or degenerate variants thereof." It is not clear whether 'degenerate variants thereof' refers to the polypeptide or the nucleic acid. This is also the

case in claims 23-29. That is, it is unclear whether the claims refer to variants of nucleic acids or variants of the ion channel. Claims 37-43 are rejected as they depend from rejected claims.

6. Claims 25, 27-29, 37-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites hybridization at "standard conditions." The specification provides "standard conditions [page 62]" as a Tm of 55°C, which is incomplete. Probe length and the precise details of hybridization buffer and washing conditions also influence hybridization. Therefore the meets and bounds of claim 25 are not known. Further, the claim recites a nucleic acid "hybridizable to" which has no structural definition other than being a nucleic acid having the capacity to bind. Thus it does not even require that it binds or hybridizes. Claims 27-29 and 37-43 are rejected as they depend from claim 25.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 7. Claims 24-25, 29, and 37-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Schrempf et al (1995).

Schrempf et al disclose the KcsA channel nucleic acid and corresponding amino acid sequences (see Figure 1, page 5171; see also appendix b and c). The KcsA of Schrempf is reasonably a "degenerate variant," meeting the limitations of claims 16 and 23-24, and also has conservative substitutions which makes it a 'conserved variant of as it relates to claim 29 and 44 (see amino acid 61, for instance). Moreover, the definition in the specification for 'conservative substitution (detailed above)' is sufficiently vague as to include any amino acid as a conservative substitution. Schrempf et al disclose several cloning vectors including those of e coli with the Lac regulatory promoter region (see page 5176, right col; see appendix A). Schrempf et al disclose plasmids with origins of replication (see PQE-32; appendix A, noted on page 5176 of Schrempf et al). Schrempf et al grow and isolate the channel from e coli bacteria (see page 5176) and isolate the protein for liposomes (see bottom right, page 5176). Thus, the limitations of claims 37-44 are met.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 8. Claim 24-29, and 37-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schrempf et al (1995) and in further view of Wilkinson (1995)

Schrempf et al teaches the nucleic acid (and protein) as described above.

Schrempf et al does not teach detectably labeling a nucleic acid 'hybridizable' to SEQ ID NO: 17 that is detectably labeled.

Wilkinson teaches labeling both RNA and DNA probes for detection of endogenous mRNA by in situ hybridization. Wilkinson's teaches both radioactive (page 20, left col) and non radioactive probes such as fluorescein (page 20, left column).

One would have a reasonable expectation of success because this technique works for every DNA/RNA. One of ordinary skill in the art would be motivated to combine the teachings of Schrempf et al with those of Wilkinson because Wilkinson teaches that labeling and in situ hybridization allows one to define spatial expression patterns of the mRNA in an organism and the labeled probe can also be used as a marker of tissue identity or physiological state (see page 20, top left, Wilkinson)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Standley whose telephone number is **(571) 272-3432**. The examiner can normally be reached on Monday through Friday, 8:00 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on **(571) 272-0867**.

The fax number for the organization where this application or proceeding is assigned is **703-872-9306**.

direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steve Standley, Ph.D.

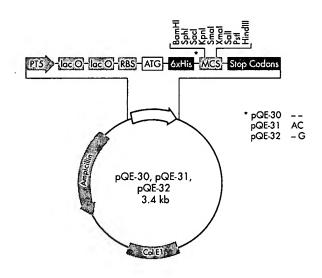
10/22/06

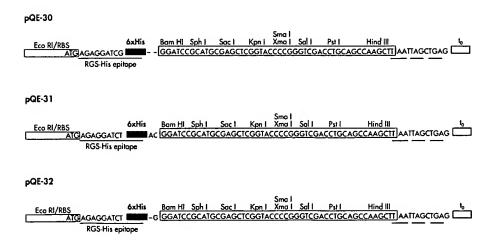
DAVID S. ROMEO PRIMARY EXAMINER

Appendix A

pQE-30, pQE-31, and pQE-32 Vectors

| Positions of elements in bases | pQE-30 | pQE-31 | pQE-32 |
|--|-----------|-----------|-----------|
| Vector size (bp) | 3461 | 3463 | 3462 |
| Start of numbering at XhoI (CTCGAG) | 1–6 | 1–6 | 1–6 |
| T5 promoter/lac operator element | 7–87 | 7–87 | 7–87 |
| T5 transcription start | 61 | 61 | 61 |
| 6xHis-tag coding sequence | 127-144 | 127-144 | 127–144 |
| Multiple cloning site | 145–192 | 147-194 | 146-193 |
| Lambda to transcriptional termination region | 208-302 | 210-304 | 209-303 |
| rmB T1 transcriptional termination region | 1064-1162 | 1066–1164 | 1065-1163 |
| ColE1 origin of replication | 1638 | 1640 | 1639 |
| β-lactamase coding sequence | 3256-2396 | 3258-2398 | 3257-2397 |





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Appendix b
RESULT 1
S60172
potassium channel protein - Streptomyces lividans
C; Species: Streptomyces lividans
C;Date: 15-Feb-1996 #sequence revision 01-Mar-1996 #text change 09-Jul-2004
C; Accession: S60172
R; Schrempf, H.; Schmidt, O.; Kuemmerlen, R.; Hinnah, S.; Mueller, D.; Betzler, M.; Ste
EMBO J. 14, 5170-5178, 1995
A; Title: A prokaryotic potassium ion channel with two predicted transmembrane segments
A; Reference number: S60172; MUID: 96080152; PMID: 7489706
A; Accession: S60172
A; Status: preliminary
A; Molecule type: DNA
A; Residues: 1-160
A;Cross-references: UNIPROT:Q54397; UNIPARC:UPI000012DCD7; EMBL:Z37969; NID:g1089905;
 Query Match
                       98.0%;
                              Score 800; DB 2; Length 160;
                       98.1%; Pred. No. 5.3e-69;
 Best Local Similarity
 Matches 157; Conservative
                             1; Mismatches
                                                          0;
                                                             Gaps
                                                                     0;
                                             2;
                                                 Indels
Qy
          1 MPPMLSGLLARLVKLLLGRHGSALHWRAAGAATVLLVIVLLAGSYLAVLAERGAPGAALI 60
            Db
          1 MPPMLSGLLARLVKLLLGRHGSALHWRAAGAATVLLVIVLLAGSYLAVLAERGAPGAQLI 60
          61 SYPDALWWSVETATTVGYGDLYPVTLWGRLVAVVVMVAGITSFGLVTAALATWFVGREQE 120
Qу
            Db
          61 TYPRALWWSVETATTVGYGDLYPVTLWGRLVAVVVMVAGITSFGLVTAALATWFVGREQE 120
Qу
        121 RRGHFVRHSEKAAEEAYTRTTRALHERFDRLERMLDDNRR 160
            <u></u>
Db
        121 RRGHFVRHSEKAAEEAYTRTTRALHERFDRLERMLDDNRR 160
```

```
Afferdix C
RESULT 2
SLSKC1G
LOCUS
          SLSKC1G
                               1161 bp
                                        DNA
                                               linear
                                                       BCT 18-APR-2005
DEFINITION S.lividans skcl gene for potassium channel protein.
ACCESSION Z37969
VERSION
          Z37969.1 GI:1089905
KEYWORDS
          potassium channel protein; skcl gene.
SOURCE
          Streptomyces lividans
 ORGANISM Streptomyces lividans
          Bacteria; Actinobacteria; Actinobacteridae; Actinomycetales;
          Streptomycineae; Streptomycetaceae; Streptomyces.
REFERENCE
          1 (bases 1 to 1161)
 AUTHORS
          Schrempf, H., Schmidt, O., Kummerlen, R., Hinnah, S., Muller, D.,
          Betzler, M., Steinkamp, T. and Wagner, R.
 TITLE
          A prokaryotic potassium ion channel with two predicted
          transmembrane segments from Streptomyces lividans
 JOURNAL
          EMBO J. 14 (21), 5170-5178 (1995)
  PUBMED
          7489706
REFERENCE
          2 (bases 1 to 1161)
 AUTHORS
          Schrempf, H.
 TITLE
          Direct Submission
 JOURNAL
          Submitted (23-SEP-1994) Schrempf H., Abt. AGM, FB Biologie /
          Chemie, Uni Osnabrueck, Barbarastr. 11, D-49090 Osnabrueck, FRG
FEATURES
                 Location/Qualifiers
    source
                  1. .1161
                  /organism="Streptomyces lividans"
                  /mol type="genomic DNA"
                  /strain="1326"
                  /db xref="taxon:1916"
    gene
                  330. .812
                  /gene="skc1"
                  330. .812
    CDS
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                  /transl_table=11
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                  /db xref="GOA:POA334"
                  /db xref="InterPro:IPR001622"
                  /db xref="InterPro:IPR003091"
                  /db xref="UniProtKB/Swiss-Prot:P0A334"
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                  YLAVLAERGAPGAQLITYPRALWWSVETATTVGYGDLYPVTLWGRLVAVVVMVAGITS
                  FGLVTAALATWFVGREQERRGHFVRHSEKAAEEAYTRTTRALHERFDRLERMLDDNRR
ORIGIN
 Query Match
                      99.2%; Score 1151.4; DB 15; Length 1161;
 Best Local Similarity
                      99.5%; Pred. No. 2.6e-228;
                                                                  0;
 Matches 1155; Conservative
                            0; Mismatches
                                                        0; Gaps
                                            6; Indels
          Qу
            Db
          61 GGTGACGCTGTCGCCGACGACCCCGACATCCGACCGACAGCCCCCGACAGCGCTCCTA 120
Qу
            Db
         Qу
        121 CGCGGTGCCGACATGACACCGCACGCCGGGGCGCGACGGGGGCTCAGGCGCGACGGG 180
```

| Db | 121 | | 180 |
|----|------|--|------|
| Qу | 181 | CGCGGATCACGACGGCCGTACCGCCGCGACGACGACCACCGCCGCCGCCGAGGAGTGG | 240 |
| Db | 181 | | 240 |
| Qу | 241 | $\tt CCGAAGGAGTGAAGATCGGTTACGGACCGTAAAGGAGTACCTGGCGCACCGGCGCGTTGT$ | 300 |
| Db | 241 | | 300 |
| Qу | 301 | $\tt CGCATCGTCCCGGCCGGTGGCGGAGCATGCCACCCATGCTGTCCGGTCTTCTGGCCA$ | 360 |
| Db | 301 | CGCATCGTCCCGGCCGGTGGCGAGCATGCCACCCATGCTGTCCGGTCTTCTGGCCA | 360 |
| Qу | 361 | GATTGGTCAAACTGCTGCTCGGGCGCCACGGCAGTGCGCTGCACTGGAGGGCCGCGGGTG | 420 |
| Db | 361 | | 420 |
| Qу | 421 | CCGCGACGGTCCTCCTGGTGATCGTCCTCCTCGCGGGCTCGTACTTGGCCGTCCTGGCTG | 480 |
| Db | 421 | CCGCGACGGTCCTCCTGGTGATCGTCCTCCTCGCGGGCTCGTACTTGGCCGTCCTGGCTG | 480 |
| Qу | 481 | AGCGCGGCGCACCGGGCGCGCGCTGATCTCGTATCCGGACGCGCTGTGGTGGTCCGTGG | 540 |
| Db | 481 | AGCGCGGCGCACCGGGCGCAGCTGATCACGTATCCGCGGGCGCTGTGGTGGTCCGTGG | 540 |
| Qу | 541 | AGACCGCGACGACCGTCGCCTACGGCGACCTGTACCCCGTGACTCTGTGGGGCCGGCTCG | 600 |
| Db | 541 | | 600 |
| Qу | 601 | TGGCCGTGGTGATGGTCGCCGGGATCACCTCCTTCGGTCTGGTGACCGCCGCGCTGG | 660 |
| Db | 601 | | 660 |
| Qу | 661 | CCACCTGGTTCGTCGGCCGGGAACAAGAGCGCCGGGGCCACTTCGTGCGCCACTCCGAGA | 720 |
| Db | 661 | CCACCTGGTTCGTCGGCCGGGAACAAGAGCGCCGGGGCCACTTCGTGCGCCACTCCGAGA | 720 |
| Qу | 721 | $\tt AGGCCGCCGAGGAGGCGTACACGCGGACGACCCGGGCGCTGCACGAGCGTTTCGACCGTT$ | 780 |
| Db | 721 | | 780 |
| Qу | 781 | TGGAGCGAATGCTCGACGACAACCGCCGGTGACTCCGCCGGTGACCGCCCGAGCGAG | 840 |
| Db | 781 | TGGAGCGAATGCTCGACGACAACCGCCGGTGACTCCGCCGGTGACCGCCCGAGCGAG | 840 |
| Qу | 841 | ${\tt GCACCGATGAGTCTGCGGCGGTTGTGCGGTCTACCCGTCGACGAAGGGAGCGCACCATGC}$ | 900 |
| Db | 841 | | 900 |
| Qу | 901 | ${\tt GCAAGATCATCTTGCACGTTCCTGACGCTGGACGGCGTCATGCAGGCGCCGGGCGGCCCGGGCGGCCGGGCGGCGGCGGGG$ | 960 |
| Db | 901 | | 960 |
| Qу | 961 | CGGACGAGGACGCCGAGAGCGGCTTCGAACACGGCGGCTGGCAGAAGCCGGTGGACGACG | 1020 |
| Db | 961 | CGGACGAGGACGCCGAGAGCGGCTTCGAACACGGCGGCTGGCAGAAGCCGGTGGACGACG | 1020 |
| Qу | 1021 | ACGAGGTCGGCACGCCATCGCCGGCTGGTACGAGGACTCCGACGCCATGCTCCTCGGCC | 1080 |

| Db | 1021 | ACGAGGTCGGCACGCCATCGCCGGCTGGTACGAGGACTCCGACGCCATGCTCCTCGGCC 1 | 080 |
|----|------|---|-----|
| Qу | 1081 | GCAAGACCTACGACATCTTCGCGTCGTACTGGCCGACCGCCGACCACCCGTTCA 1 | 140 |
| Db | 1081 | GCAAGACCTACGACATCTTCGCGTCGTACTGGCCGACCGCCGACCACCCCGTTCA 1 | 140 |
| Qу | 1141 | CCCATCGGATGAACAGCATGC 1161 | |
| Db | 1141 | CCCATCGGATGAACAGCATGC 1161 | |